

REMARKS

Claims 16-30 and 70-75 are currently pending. In view of the remarks that follow, Applicants respectfully request further and favorable consideration.

Election/Restriction Requirement

The Office Action asserts that it is setting forth a restriction requirement to one of the following inventions:

- I. Claims 16-30 are drawn to secure communications between a mobile device and home domain using a foreign domain, classified in class 380, subclass 248.
- II. Claims 70-75 are drawn to a method of dynamically establishing security associations, classified in class 726, subclass 15.

Applicants respectfully traverse this requirement on the grounds that the Examiner has not established a *prima facie* showing that there will be a serious burden if restriction is not required. In a telephone conference with the Examiner on August 10, 2007, the undersigned pointed out the problems with restriction requirement, and requested appropriate correction. The Examiner maintained that the restriction requirement was proper and indicated that it would be acceptable to call the Examiner's supervisor. In a first telephone conference with Supervisory Primary Examiner (SPE) Zand on August 10, 2007, attorneys Murray Smith (Reg. No. 30,222) and the undersigned discussed whether the restriction requirement was proper. SPE Zand indicated that he would review the case and get back to Mr. Smith. In a second telephone conference with SPE Zand on August 14, 2007, Supervisor Zand indicated to Mr. Smith that the restriction requirement was proper under MPEP §811 and 811.02. To follow up, Mr. Smith called SPE Zand on August 15, 2007 and left a voicemail pointing out an apparent defect in the restriction requirement. No further calls from SPE Zand were received before the due date of this response.

MPEP §811 provides that, “[b]efore making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required.” (Emphasis added). In the present application, claims 16-30 and 70-75, as they currently stand, have been fully examined and were on appeal as set forth in the appeal brief filed on March 29, 2007.

In requiring restriction, the Examiner asserted that, “[b]ecause these inventions...have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.” (See Office Action, pg. 3). The Examiner points to claims 16-30 as being classified in class 380, subclass 248, and claims 70-75 as being classified in class 726, subclass 15. This showing of different classifications might be sufficient if the claims have not been examined. However, in the present application, this showing of different classifications does not, by itself, establish a serious burden on the Examiner. As previously stated, claims 16-30 and claims 70-75, as they currently stand, have been searched, examined, placed under final rejection, and appealed. As such, the Examiner has had the opportunity to thoroughly search and examine the subject matter of all the pending claims. Thus, it is very difficult for the Examiner to establish a serious burden because the threshold is higher now than what would have been the case if the restriction requirement was presented before the first action on the merits. In any event, the Examiner has not provided sufficient reasons in the present Office Action as to the existence of a serious burden if the restriction is not required.

The Examiner also asserted that, “[b]ecause these inventions are distinct...and the search required for Group I is not required for Group II, the search required for Group II is not required for Group I, restrictions for examination purposes as indicated is proper.” Applicants respectfully disagree. From the USPTO website, a classification order dated August 2, 2005 established new class 726, subclasses 1-36. (See <http://www.uspto.gov/web/offices/opc/documents/1839.pdf>). Applicants submit that the Examiner was aware of these classifications when the initial search was performed since a first Office Action on the merits was provided in March 17, 2006, seven months after the

classification order. Class 726 is the “new” class that the Examiner alleges as requiring further search to address claims 70-75. The classification order also indicated that class 380, which was already searched by the Examiner, would be impacted by this order. In the first Office Action, the Examiner cited Tisdale (U.S. Patent 5,708,716) which is classified in class 380, subclass 247. Additionally, the Classification Manual for class 380, subclass 247, provides a cross-reference to class 726, subclasses 1-36, which is now being relied upon by the Examiner to address 70-75. (See <http://www.uspto.gov/web/patents/classification/uspc380/defs380.htm#C380S247000>).

Thus, the Examiner would have seen cross-reference to both Classes and Subclasses. The existence and potential applicability of these two search areas is not a “revelation” that has only now come into existence, since roadmaps directing the Examiner to these search areas existed at the time of the first Office Action. Applicants submit that the extent of cross-referencing negates the assertion as to the inventions being “separate and distinct,” requiring searching in different areas.

The PTO requires that Applicants reply to a restriction requirement, even if Applicants offer a valid traverse. Accordingly, as between the claim groups set forth in the Office Action, Applicants elect Group 1 (Claims 16-30).

Conclusion

It is clear from all of the foregoing that the Examiner has not established a showing that there would be a serious burden if restriction was not required as specified in MPEP § 811. As such, the restriction requirement as set forth above is not proper and should be withdrawn, and all pending claims should be examined on the merits. Further, Applicants are especially concerned at what it views as needless, unnecessary, and wasteful churn for 5 years in the Patent Office of Amendments and a comprehensive and well-reasoned Appeal Brief, to only now come to the point of a restriction requirement.

The Examiner is invited to call the undersigned at the below-listed number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,



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on:	<u>Aug. 24, 2007</u>
	<u>Bonnie Boyle</u>
	Signature of person mailing paper and fee